

REMARKS

The Examiner has rejected Claim 22 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has stated that “applicant’s specification does not describe what is considered to be tangible or not tangible.”

Applicant respectfully disagrees and directs the Examiner’s attention to Page 16 of the Specification, which discloses that “[e]xemplary computer readable storage media include CD-ROM, floppy disk, tape, flash memory, system memory, and hard drive” (Page 16, lines 1-3). Therefore, applicant asserts that applicant’s claimed “computer product embodied on a tangible computer readable storage medium” (emphasis added), as currently claimed, is clearly definite. Of course, the above citation is merely an example of the above claim language and should not be construed as limiting in any manner.

The Examiner has rejected Claims 13, and 22-26 under 35 U.S.C. 101, as being directed to non-statutory subject matter. Applicant respectfully asserts that such rejection is deemed avoided in view of the amendments made hereinabove to independent Claims 13 and 22. Specifically, with respect to Claim 22, applicant respectfully asserts that such claim recites a “tangible computer readable storage medium” (emphasis added), which is not described in applicant’s specification as “a data signal embodied in a carrier wave” as the Examiner suggests.

The Examiner has rejected Claims 1-8, 10-31 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully disagrees and directs the Examiner’s attention to Page 15 of the Specification, which discloses that “[e]ach MSP is responsible for reporting spammers to authorities once enough evidence has been collected from one or more organizations for a particular SPAM threat” (Page 15, lines 7-9 – emphasis added). Therefore, applicant asserts that

applicant's claimed "the central managed service provider... reports to the hosting authority once a predetermined amount of threat information has been collected" (emphasis added), as claimed, clearly complies with the written description requirement. Of course, the above citation is merely an example of the above claim language and should not be construed as limiting in any manner.

The Examiner has rejected Claims 1-8, and 10-31 under 35 U.S.C. 103(a) as being unpatentable over Aronson et al. (U.S. Patent No. 6,654,787), in view of Hall (U.S. Patent No. 6,915,334), and in further view of Leeds (U.S. Patent No. 6,393,465). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to the independent claims.

With respect to the independent claims, the Examiner has relied on Col. 10, lines 1-12 (excerpted below) from the Hall reference to make a prior art showing of applicant's claimed "transmitting the report to a central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected" (see this or similar, but not necessarily identical language in the independent claims). Specifically, the Examiner has argued that "Hall mentions collection of the SPAM list from users at a central server and then making the SPAM list globally available to users" such that "[i]f the list can be made globally available to users as Hall suggested then it can be just as easily be made available to one or more hosting authorities (I.E. Internet Service Provider) to curtail the SPAM associated with SPAM list."

"Collaborative Filtering

In collaborative filtering, users report spam messages to a central server, which records them and makes the list of such messages globally available to all users. When a user's mail software receives a new message, it checks it against the server's list; if found, it is discarded. Thus, in the best case, shortly after the first user reports a spam message, no other users are bothered by that message. Clearly, if every user reports every spam message seen, then only one user sees each message. (For this analysis, we ignore the geographic distribution of users which may lead to other users seeing the

message before the first user's report reaches the server.) (Col. 10, lines 1-12 - emphasis added)

Applicant respectfully disagrees and asserts that the excerpt from Hall relied upon by the Examiner merely teaches that "users report spam messages to a central server, which records them and makes the list of such messages globally available to all users" and that "if every user reports every spam message seen, then only one user sees each message" (emphasis added). Further, the excerpt teaches that "in the best case, shortly after the first user reports a spam message, no other users [are] bothered by that message," since "[w]hen a user's mail software receives a new message, it checks it against the server's list" (emphasis added).

First, teaching that users report spam messages to a central server that makes the list of such messages globally available to all users, where if every user reports every spam message seen, then only one user sees each message, in addition to teaching that when a user's mail software receives a new message, it checks the new message against the server's list, where, in the best case, shortly after the first user reports a spam message, no other users are bothered by that message, as in Hall, simply fails to teach "transmitting the report to a central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected" (emphasis added), as claimed by applicant.

Second, a central server making the list of spam messages globally available to all users, where a user's mail software checks the server list when it receives a new message, as in Hall, simply fails to even suggest that "the central managed service provider... reports to the hosting authority," much less that "the central managed service provider... reports to the hosting authority once a predetermined amount of threat information has been collected" (emphasis added), as specifically claimed by applicant. Clearly, a central server making the list available to all users, as in Hall, simply fails to teach that "the central managed service provider... reports to the hosting authority" (emphasis added), as specifically claimed by applicant.

By virtue of the Examiner's rejection of applicant's aforementioned claim language, namely that "[i]f the list can be made globally available to users as Hall suggested then it can be just as easily be made available to one or more hosting authorities (I.E. Internet Service Provider) to curtail the SPAM associated with SPAM list," it appears that the Examiner has simply dismissed the same under Official Notice. In response, applicant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Hall. Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

"If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position." See MPEP 2144.03.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has amended the independent claims to further distinguish applicant's claim language from the Hall reference, as follows:

“wherein reporting to the hosting authority includes the central managed service provider transmitting a hosting authority message including the collected threat information to the hosting authority” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that, as argued hereinabove, Hall teaches that a central server makes the list of spam messages globally available to all users, where a user’s mail software checks the server list when it receives a new message, which simply fails to suggest applicant’s claimed technique “wherein reporting to the hosting authority includes the central managed service provider transmitting a hosting authority message including the collected threat information to the hosting authority” (emphasis added), as claimed by applicant.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Still yet, applicant brings to the Examiner’s attention the subject matter of new Claims 32-33 below, which are added for full consideration:

“wherein the hosting authority message that the central managed service provider transmits to the hosting authority includes a hosting authority report that includes a content of the message, a date and time the message arrived on a recipient’s server, an IP address and name reported during an SMTP connection associated with the message, and a full WHOIS report used to track down the hosting authority” (see Claim 32); and

“wherein the hosting authority message that the central managed service provider transmits to the hosting authority is signed to verify the central managed service provider as a source of the hosting authority message” (see Claim 33).

Again, a notice of allowance or a proper prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

To this end, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NA11P314).

Respectfully submitted,
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